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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,993	02/14/2002	George C. Myers III		6637
7590	07/25/2005		EXAMINER	
George C. Myers, Jr. 197 Elighth street Apt 212 Charlestown, MA 02129			WILLATT, STEPHANIE L	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/073,993	MYERS, GEORGE C.
	Examiner Stephanie L. Willatt	Art Unit 3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,10 and 13 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3,10 and 13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stewart.

Stewart discloses a hair device simulating the appearance of a dog or cat, as shown in Figures 3-10. The toy comprises a tubular body portion (10) simulating a first part of the anatomy of the given animal. The body portion (10) has two ends and is adapted to have hair wrapped about it between the two ends, since the body portion (10) is capable of having hair wrapped about it. One end of the toy simulates the head portion of the animal, including the front legs, and the other end of the toy simulates the hind end (where hind legs 16 meet the body 10) of the animal. A tail comprising

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bendable wire is attached to the animal hind portion. The head and hind are made of plastic through injection molding, as discussed in column 3, lines 12-21. The means for holding the hair to the body portion comprises appendages (16), which are described in column 4, lines 6-36.

Stewart does not disclose how exactly the parts of the hair device are molded, i.e. the head portion being molded separately from the body portion. However, as stated in MPEP 2113, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.' *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)" In this case, the product of Stewart is the same as the product recited in claim 1. However, in the case that the product of Stewart is not the same as the product recited in claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to mold the animal head portion of a plastic material separate from the body portion, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

4. Claims 1, 3, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett in view of Gumb and Schneeweis.

Barrett discloses a hair curler (roller R) comprising a body portion about which hair may be wrapped (Figure 1). A means for holding the hair to the body portion includes a pin (20 and 22), as discussed in column 4, lines 10-28. The Barrett does not disclose an animal head portion or hind portion attached to the body. However, Barrett discloses an ornament (O), which is separate from the body portion, attached to each side of the body portion in Figures 3 and 4. The plastic ornaments (O) are illustrated as a flower, but column 2, lines 50-53 state that the ornament can be "a flower or any similar decorative item". Schneeweis and Gumb disclose decorative combs. The decorative ornament in Schneeweis is a plurality of flowers. The decorative ornament in Gumb is a rabbit with a head, a hind end with a tail attached to it, and a middle body section. Together, Schneeweis and Gumb teach that it is obvious to substitute one ornament for another. Specifically, Schneeweis and Gumb teach that it is obvious to substitute an animal-shaped ornament (rabbit) for a flower-shaped ornament. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an animal head portion (including a head and front legs), body portion, and hind portion (including tail and hind legs) in place of the flower ornaments, as taught by Schneeweis and Gumb, in order to substitute a another similar decorative item, in this case an animal, for a flower.

Barrett does not disclose the process of making the hair curler or the ornaments. However, as stated in MPEP 2113, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the

product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.' *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)"

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett in view of Gumb and Schneeweis as applied to claims 1, 3, and 13 above, and further in view of Catania.

Barrett discloses the features discussed above, but does not disclose that the body portion comprises a mesh covered coil spring surrounding a bristle brush. Catania discloses a hair curler body portion (roller 12) including a mesh covered coil spring (46) surrounding a bristle brush (50), as described in column 2, lines 35-43. A pin (bottom member 14) passes through the mesh covered coil spring (46) and the bristle brush (50), as shown in Figure 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the body portion of Catania for the body portion of Barrett, since it is an art recognized functional equivalent.

Response to Arguments

6. Applicant's arguments filed 9 May 2005 have been fully considered but they are not persuasive. Applicant argues that the appendages of Stewart are only 5/16 inches apart, and therefore, the body of Stewart cannot be used as a hair curler. However,

hairs are much less in diameter than 5/16 inches. Therefore, a strand of hair could be wrapped around the body of Stewart.

Applicant argues that Gumb and Schneeweis do not teach that the ornaments of Barrett should be made in the form of different portions of the anatomy of an animal. However, Schneeweis discloses a comb with ornaments in the form of flowers and Gumb discloses a comb with ornaments in the form of different portions of the anatomy of a rabbit. As design patents, it is inherent that the purpose of the flowers and the rabbit is ornamental. The existence of two design patents with either a flower or an animal as ornaments teaches that it is obvious to substitute one for the other as ornaments. Barrett refers to his flowers as "ornaments." Since Schneeweis and Gumbo teach that it is obvious to substitute flowers for ornaments, and Gumbo even discloses a head and hind portion of an animal, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an animal head portion (including a head and front legs), body portion, and hind portion (including tail and hind legs) in place of the flower ornaments

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie L. Willatt whose telephone number is (571) 272-4721. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


slw


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